UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,845	06/27/2003	Hyou Takahashi	Q76336	4812

23373 7590 11/10/2004

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
LE, HOA VAN	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,845	TAKAHASHI ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *1,5,7,8,11 and 13-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-4,6,9-10,12, 17-20 and 21 with respect to the elected and applied species* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *27 June 2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to Paper filed on 01 October 2004.

I. Applicants elect the invention of Group II, claims 2-4,6,9-10, 12, 17-20 and 21, without traverse being acknowledged.

II. Applicants elect species of (a) compound A-1 for the chemical structure of the general formula (1) and its counter ion, (b) MM-1 as crosslinking agent, (c) OE-2 nitrogen-containing basic compound and (d) R-20 as both (*) alkali-soluble resin and (**) resin capable of...of an acid.

III. The elected species have been considered and searched. The consideration and search are extended to the applied species. Others have not been considered or searched until the elected and applied species are overcome.

IV. A. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, conditional, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte

Phillip, 28 USPQ2d 1302. Please also see the related issue with respect no patentable sense as stated in In re Hutchison, 69 USPQ 138. The language "resin capable of...of an acid ", "compound capable of...of an acid", "nitrogen-containing basic compound" or the like is considered as property of a material and searched as appeared.

B. In re Schreiber, 44 USPQ2d 1429 states that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart...169 USPQ 226, 228...Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart...where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject mater may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." A statement or argument alone may have and be given a little to no value because it is not factual evidence.

V. Applicants' prior art submission filed on 27 June 2003 has been considered.

VI. The record shows that applicants, Fuji Photo Film Co. and their counsel fail to bring to the Office the related applications, especially with at least 10/361,505, 10/613,044 and 10/654,942.

VII. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The elected invention of claims 2-4, 6, 9-10, 12, 17-20 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (1) 2-8 and 16 of copending Application No. 10/361,505, (2) 16-20 of copending Application 10613,044 and (3) 3-4, 6, 8, 11-12, 14, 16, and 18 . Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same or about the same requisite chemical ingredients which are not found to be patentably different or distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

VIII. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The elected invention of claims 2-4, 6, 9-10, 12, 17-20 and 21 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Sinta et al (5,731,364 as submitted) and Sato et al (6,238,842).

Sinta et al disclose, teach and suggest a positive resist composition comprising a sulfonium and its counter ion being read within the general formula I as claimed and resin being read on the type as claimed. Please see the whole disclosure of each of the applied references, especially in Sinta et al at col.1:56 to 2:9, 3:24-58, 4:23 to 5:32, compound A on col.6:1-22, 8:31 to 9:51 and Example 2. Sato et al is cited to show the known use of chemical ingredients, especially at col.149:27 to 150:40 to show nitrogen-containing basic compound. Since the above references are related to positive photoresist compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use, include or cite a nitrogen-containing compound from Sato et al in Sinta et al positive photoresist compositions for the advantage of sufficient developing and exposed image as disclosed, taught and suggested in Sato et al.

IX. The elected invention of claims 2-4, 6, 9-10, 12, 17-20 and 21 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al (6,406,830).

Inoue et al disclose, teach and suggest a positive resist composition comprising a sulfonium and its counter ion being read within the general formula I as claimed and resin being read on the type as claimed. Please see the whole disclosure of each of the applied references, especially in Inoue et al at col.2:44 to 62, 3:44 to 5:28, 6:47 to 11:65, nitrogen-containing basic

compound on col.12:2 to 13:29 and Examples. Since Inoue et al disclose, teach and suggest the requisite chemical ingredients in the photoresist compositions as claimed, the above claims are found to be rendered prima facie obvious by Inoue et al.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
08 November 2004

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le